

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: A7483

Xiao-Mai ZHOU

Appln. No.: 09/580,523

(U.S. Patent 7,193,044, issued March 20, 2007)

Group Art Unit: 1642

Confirmation No.: 8284

Examiner: Minh Tam Davis

Filed: May 30, 2000

For: COMPOUNDS AND METHODS FOR REGULATING APOPTOSIS, AND METHODS
OF MAKING AND SCREENING FOR COMPOUNDS THAT REGULATE APOPTOSIS

**REQUEST FOR RECONSIDERATION OF DECISION ON REQUEST FOR
RECONSIDERATION OF PATENT TERM ADJUSTMENT**

MAIL STOP PATENT EXT.

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Decision on Petition mailed January 7, 2008 for the above-identified application.

Applicants timely filed a Request for Reconsideration of Patent Term Adjustment on May 7, 2007. The Request for Reconsideration was based on the assertion that the PAIR entry of a reduction of PTA of 120 days for a Miscellaneous Incoming Letter filed September 20, 2006 does not correspond to a failure by Applicant to engage in reasonable efforts to engage in prosecution. This is because the paper that was submitted on September 20, 2006, was a Request for Notice of Recordation of Assignment, which did not require a response from the Examiner.

Applicant's Request was dismissed on the basis that: (1) the Request for Notice of Recordation of Assignment is not among the examples of papers that are not considered "a

failure to engage in reasonable efforts” to conclude processing or examination of an application under 37 C.F.R. § 1.704(c)(10); (2) since the paper was styled as a Request, the Examiner was required to at least review the paper to determine if a response was necessary; and (3) the filing of the paper was unnecessary.

Applicants believe that the PTO has not considered the whole set of facts in the case and has improperly dismissed the petition. Therefore, this Request for Reconsideration is being submitted based on the following facts relating to the matter of the Request for Notice of Recordation of Assignment.

1. Applicants initially submitted a copy of the Assignment, Assignment Recordation Form Cover Sheet and the required fee of \$40.00 for recordation of the Assignment on August 4, 2000, *inter alia*, by hand delivery to the U.S. PTO. A copy of the date stamped receipt and the aforementioned papers are attached as Attachment (A).

2. The PTO failed to record the Assignment and did not provide Applicants with any reason as to why the assignment was not recorded.

3. Upon finding that the Assignment previously filed on August 4, 2000 had not been recorded, Applicants submitted a Request for Notice of Recordation including a copy of the previously submitted Assignment and Assignment Recordation Form Cover Sheet via the electronic filing system (EFS) to quickly have the assignment recorded and receive the Notice of recordation in accordance with the US PTO’s current practice.

In view of the above, Applicant submits that the filing of the Request for Notice of Recordation of Assignment on September 20, 2006 was necessitated by the U.S. PTO’s failure to record the Assignment upon receipt of the initial submission of the Assignment, Assignment Recordation Cover Sheet and the required fee. In view thereof, Applicant should not be penalized for attempting to rectify an error on the part of the PTO.

Further, applicants note that although the original Application for Patent Term Adjustment indicates that the Request for Notice of Recordation of Assignment was “inadvertently filed in the file wrapper”, Applicant would like to clarify that the filing the Request itself was not inadvertent as it was considered necessary to have the unrecorded

Assignment recorded and to obtain the Notice of Recordation of Assignment as evidence thereof.¹ Further, in order to have the patent issue in the name of the Assignee, the assignment must have been recorded or filed for recordation in accordance with 37 C.F.R. § 3.11. See MPEP §307 and 37 C.F.R. §3.81.

Additionally, the Request for Notice of Recordation of Assignment was filed electronically because the PTO encourages electronic filing. In this regard, the MPEP §302.10 specifically provides that “Assignments and other documents affecting title may be submitted to the Office via the Office’s Electronic Filing System (EFS) or the Electronic Patent Assignment System(EPAS). However, if filing electronically, the MPEP §302.10 only allows for filing a previously unrecorded assignment via EFS. Resubmission of a non-recorded assignment is specifically indicated as a document which cannot be filed using EPAS. In fact, a resubmission of a non-recorded assignment cannot be filed via facsimile. Therefore, the only other option was a paper filing, which had already been attempted with the initial filing on August 4, 2000, and did not result in recordation of the assignment. Thus in view of the above, it seemed most prudent to electronically file the re-submission via EFS, to have the Assignment recorded and receive the Notice of Recordation as evidence thereof and to have the patent issue in the Assignee’s name as intended.

Regarding the Office’s first reason for dismissing the Request for Reconsideration of Patent Term Adjustment that the Request for Notice of Recordation of Assignment is not among the examples of papers that are not considered “a failure to engage in reasonable efforts” to conclude processing or examination of an application under 37 C.F.R. § 1.704(c)(10), Applicants note that the list of papers that are not considered as “a failure to engage in reasonable efforts” to conclude processing or examination of an application under 37 C.F.R. § 1.704(c)(10) set forth in the OG Notice of June 26, 2001 is not exhaustive, but is merely exemplary. Specifically in the notice it states:

¹ The paper was inadvertently categorized as a Miscellaneous Incoming Letter and placed in the IFW instead of being sent to the Assignment Branch to address the Request.

the Office is publishing this notice *to provide guidance* in interpreting the provisions of 37 CFR 1.704(c)(10) to clarify that submission of certain papers after a "Notice of Allowance," *which do not cause substantial interference and delay in the patent issue process*, are not considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application. The following are examples of such papers: (1) Issue Fee Transmittal (PTOL-85B), (2) Power of Attorney, (3) Power to Inspect, (4) Change of Address, (5) Change of Status (small/not small entity status), (6) a response to the examiner's reasons for allowance, and (7) letters related to government interests (e.g., those between NASA and the Office). Therefore, the submission of these papers after a Notice of Allowance will not be considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application and would not result in reduction of a patent term adjustment pursuant to 37 CFR 704(c)(10) (emphasis added).

Thus, it is clear that the list of papers provided for in this portion of the OG Notice are examples and are not all papers "which do not cause a substantial interference and delay in the patent issue process". The Request for Notice of Recordation of Assignment (re-submission of non-recorded assignment) filed by Applicants is analogous to the papers listed in this portion of the OG Notice such as: (2) Power of Attorney, (3) Power to Inspect, (4) Change of Address, (5) Change of Status (small/not small entity status), which are handled by personnel other than the Examiner and do not require review, action or even consideration by the Examiner. Similar to the papers listed in the OG Notice as examples of papers "which do not cause a substantial interference and delay in the patent issue process", there are no statutory time limits set for recordation of assignment and such recordation does not interfere with or delay the patent issue process. For at least this reason, Applicants should not be charged with unreasonable delay in trying to have an assignment recorded, which was previously submitted for recordation, as in this

case. Indeed the PTO has published OG Notices stating that the fastest way to have assignments processed is to file via the Internet and an OG Notice dated October 30, 2007, near the time the Request for Notice of Recordation was filed, indicates that the actual processing time for assignment recordation was 1 day, which cannot be considered as a substantial interference or delay in the patent issue process. See OG Notice dated October 30, 2007 attached as Attachment B.

Regarding the Office's second reason for dismissing the Request for Reconsideration of Patent Term Adjustment that the Examiner was required to at least review the paper to determine if a response was necessary, Applicant respectfully submits that there is a separate Assignment Branch which handles recordation of Assignments and related issues. Specifically, it is preferable to file assignment documents by e-filing since e-filing is supposed to provide the advantage of allowing customers to submit documents directly into the automated Patent and Trademark System and receive the resulting notice of recordation shortly thereafter. Therefore, it is implied that all papers related to assignment documents for recordation, regardless of how or when they are filed, will be forwarded to the Assignment Branch and processed without interference with the examination or processing of the application. Thus, it follows that there is no reason, regardless of how or when a paper is filed that a paper entitled "Request for Notice of Recordation of Assignment" should be forwarded to the Examiner for review and consideration and/or considered as a paper which causes substantial interference and delay in the patent issue process. MPEP §301(V) states that "recording of an assignment is merely a ministerial act; it is

not an Office determination of the validity of the assignment document nor the effect of the Assignment document on ownership of the patent property”.

Also, it is very unlikely that the Request for Notice of Recordation of Assignment was ever forwarded to the Examiner, but even if it was, Applicants submit this would have been another error on the part of the PTO since the paper was clearly titled “Request for Notice of Recordation of Assignment” and it was clearly indicated that the attached documents had been previously submitted for recordation and that the Notice of the Recordation was being requested.

Finally, regarding the Office’s third reason for dismissing the Request for Reconsideration of Patent Term Adjustment that the filing of the paper was unnecessary, as stated above, the Request for Notice of Recordation of Assignment on September 20, 2006 was necessitated by the U.S. PTO’s failure to record the Assignment upon receipt of the initial submission of the Assignment, Assignment Recordation Cover Sheet and the required fee. Further, in order to have the patent issue in the name of the Assignee, the assignment must have been recorded or filed for recordation in accordance with 37 C.F.R. § 3.11. See MPEP §307 and 37 C.F.R. §3.81. The Office mentions 37 C.F.R. §3.27, 3.28 and 3.31 as setting forth the procedures for filing assignment documents and cover sheets to be recorded; however, these sections do not specifically address the situation where these procedures are followed as in the present case and the PTO fails to record the Assignment. Rule 3.27 provides the mailing address for submission of documents for recordation, but there is no requirement for mailing and no indication that mailing such documents is preferable over other methods such as e-filing (which is encouraged by the Office). Also, as noted above, the assignment documents were initially

paper filed by hand; received in the Office as evidenced by the Official date-stamped receipt; and not recorded.

In summary, Applicants request reconsideration of the Decision dismissing the Request for Reconsideration of Patent Term Adjustment in view of the facts that; (1) the Request for Notice of Recordation of Assignment was necessitated by the PTO's initial failure to properly record the assignment upon receipt of the initial assignment papers; (2) it was necessary to submit the Request for Notice of Recordation of Assignment in order to have the patent issue in the name of the assignee; and (3) such submission of assignment-related documents after mailing of the Notice of Allowance should not cause a substantial interference and delay in the patent issue process as such papers are handled by the Assignment Branch of the U.S. PTO.

Conclusion

In view of the above and in view of the prior Application for Patent Term Adjustment, Applicant respectfully requests correction of the Office's records and adjustment of the Office's calculation of term adjustment by adding 120 days of patent term adjustment, making the total adjustment **1224** days (667 days of USPTO adjustment + 1137 days of Office delay - 580 days of Applicant delay).

Respectfully submitted,

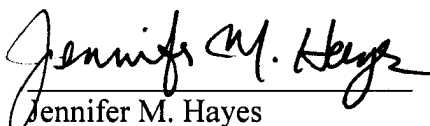
SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: March 7, 2008


Jennifer M. Hayes
Registration No. 40,641

ATTACHMENT - A

3 pages

72

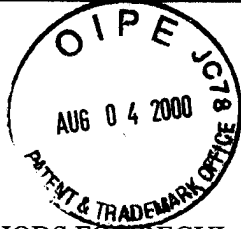
FILING RECEIPT
PLEASE DATE STAMP AND RETURN TO US - BOX 235X

In re application of

Xiao-Mai ZHOU

Appln. No. 09/580,523

Filed: May 30, 1999



Group Art Unit: unassigned

Examiner: unassigned

For: COMPOUNDS AND METHODS FOR REGULATING APOPTOSIS, AND METHODS OF
MAKING AND SCREENING FOR COMPOUNDS THAT REGULATE APOPTOSIS

PAPER(S) FILED ENTITLED:

1. RESPONSE TO NOTICE TO FILE MISSING PARTS (in duplicate)
2. COPY OF NOTICE TO FILE MISSING PARTS
3. ASSIGNMENT RECORDATION FORM COVER SHEET (with Check No. 156391 in the amount of \$40.00)
4. ASSIGNMENT
5. DECLARATION AND POWER OF ATTORNEY
6. STATEMENT TO SUPPORT FILING AND SUBMISSION IN
ACCORDANCE WITH 37 C.F.R. §§ 1.821-1.825
7. PAPER COPY OF SEQUENCE LISTING
8. STATUTORY FILING FEE (with Check No. 156389 in the amount of
\$2820.00)
9. SURCHARGE FOR LATE FILING OF BASIC FILING FEE OR OATH
OR DECLARATION (with Check No. 156390 in the amount of \$130.00)

SUGHRUE, MION, ZINN,
MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

DOCKET NO.: A7483
ATTORNEY/SEC: WAB/MAH/maf

Date Filed: August 4, 2000

RECORDATION FORM COVER SHEET
PATENTS ONLY

To the Assistant Commissioner of Patents. Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

Xiao-Mai ZHOU

Additional name(s) of conveying party(ies) attached?

☐ yes

☒ no

2. Name and address of receiving party(ies)?

APOPTOSIS TECHNOLOGY, INC.

128 Sidney Street

Cambridge, MA 02139-4239

USA

3. Nature of Conveyance:

☒ Assignment

☐ Merger

☐ Security Agreement

☐ Change of Names

☐ Other

Additional name(s) & address(es) attached?

☐ yes

☒ no

Execution Date: May 22, 2000

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is:

A. Patent Application No.(s)
09/580,523

B. Patent No.(s)

Additional numbers attached?

☐ Yes

☒ No

FILED

AUG 4 2000

5. Name and address of party to whom correspondence concerning document should be mailed:

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC

2100 Pennsylvania Avenue, N.W.

Suite 800

Washington, D.C. 20037-3213

6. Total number of applications and registration involved:

1

7. Total Fee (37 CFR 3.41): \$40.00

☒ Enclosed. Please charge any underpayment in connection with this Assignment to Deposit Account No. 19-4880.

☐ Authorized to be charged to Deposit Account

8. Deposit Account No.

19-4880

DO NOT WRITE IN THIS SPACE

9. Statement and Signature.

To the best of my knowledge and belief the foregoing information is true and correct and any attached copy is a true copy of the original document.

Waddell A. Biggart

Reg. No. 24,861

August 4, 2000

Date

TOTAL NUMBER OF PAGES COMPRISING COVER SHEET, ATTACHMENTS AND DOCUMENT: 2

OMB No. 0651-0011 (exp. 4/94)

Do not detach this portion

Mail documents to be recorded with required cover sheet information to:

Assistant Commissioner of Patents

Box Assignments

Washington, D.C. 20231

ASSIGNMENT

WHEREAS, the following individual:

- Xiao-Mai Zhou, Brookline, MA, US,

hereinafter called "Assignor", has invented certain improvements in the following patent application, as identified below:

U.S. Provisional Patent Application Serial No. 60/136,783, hereinafter called "the '783 provisional application", filed May 28, 1999, entitled "PROTEINS FOR CONTROLLING APOPTOSIS, ANTIBODIES THERETO, METHOD OF CONTROLLING APOPTOSIS, AND ASSAYS FOR APOPTOSIS CONTROL AGENTS" naming the above individual as inventor;

WHEREAS, APOPTOSIS TECHNOLOGY, INC., a U.S. corporation organized under the laws of the state of Massachusetts, having its principal place of business at 148 Sidney Street, Cambridge, MA 02139-4239, US, desires to acquire the entire right, title and interest in the '783 provisional application and the invention disclosed and claimed therein with respect to any Letters Patent issuing thereon, or issuing on any subsequently filed United States patent applications which claim the benefit of the provisional application's filing date; and

NOW, THEREFORE, for One Dollar (\$1.00) and other valuable consideration, receipt whereof is hereby acknowledged,

The above named Assignor hereby sells, assigns and transfers to APOPTOSIS TECHNOLOGY, INC., its successors and assigns, the entire right, title and interest in the '783 provisional application and the invention disclosed therein for the United States of America, and all countries foreign thereto including rights of priority under the International Convention of Paris (1883) as amended, and as to the United States, we request the Commissioner of Patents to issue any Letters Patent granted upon the invention set forth in the application to APOPTOSIS TECHNOLOGY, INC., its successors and assigns; and I hereby agree that APOPTOSIS TECHNOLOGY, INC. may apply for foreign Letters Patents on the invention and I will execute without further consideration all papers deemed necessary by APOPTOSIS TECHNOLOGY, INC. in connection with the United States and foreign applications when called upon to do so by APOPTOSIS TECHNOLOGY, INC.

Date: May 22, 2000

Xiao-mai Zhou
Xiao-Mai Zhou

ATTACHMENT - B

2 pages

United States Patent and Trademark Office OG Notices: 30 Oct 2007

Status of Public Records Division

The Public Records Division (PRD) processes and fills orders for both certified and uncertified copies of Patent and Trademark Office documents and records assignments and other documents related to title. This is an update of actual processing times for orders filled during the month of September 2007:

Document Services	Goal	Actual Processing Time
Certified Documents		
Patent Applications-As-Filed	7 days	5 days
Patent Related File Wrappers	25 days	23 days
Patent Copies	10 days	4 days
Patent Assignments	10 days	5 days
Trademark Applications-As-Filed	7 days	4 days
Trademark Related File Wrappers	25 days	12 days
Trademark Assignments	10 days	6 days
Trademark Registrations, Expedited	5 days	2 days
Trademark Registrations, Regular	14 days	4 days

Uncertified Documents

Patent Copies	5 days	1 day
Plant Patents	5 days	2 days
Patent Assignments	10 days	2 days
Patent Related File Wrappers	25 days	12 days
Trademark Copies	5 days	1 day
Trademark Assignments	10 days	1 day
Trademark Related File Wrappers	25 days	6 days

Customers should use the above actual processing time for each product as a guide as to when they can expect their orders to be completed. In cases where an urgent deadline is approaching, contact Document Services Customer Service at (571) 272-3150 or 1 (800) 972-6382 for assistance with a particular order.

Customers are encouraged to place orders through the Internet at <http://ebiz1.uspto.gov/oems25p>

Orders may also be faxed to the Document Services Branch at (571) 273-3250. Information on the status of pending orders may be obtained by calling (571) 272-3150 or 1 (800) 972-6382 (outside the Washington, DC Metro area), or via E-mail to dsd@uspto.gov.

ASSIGNMENT SERVICES	Goal	Actual Processing Time
Submission Method		
Internet (EFS, ePAS or eTAS)	2 days	1 day
Fax	10 days	1 day
Paper	14 days	1 day

The Assignment Services Branch is currently mailing recordation notices for

paper documents received in the Public Records Division on January 30, 2007.

Customers should use the above actual processing times as a guide as to when they can expect their assignment submissions to be processed. For fastest service customers are encouraged to file assignments via the Internet.

Assignment submissions may be made via the Internet at <http://epas.uspto.gov/> for patent assignments and <http://etas.uspto.gov> for trademark assignments. Patent assignment submissions may also be made by selecting the "Electronic Filing (EFS)" option at <http://www.uspto.gov/ebc>.

Assignment submissions may also be faxed to the Assignment Services Branch at (571) 273-0140. Trademark assignment recordations may be reviewed online at <http://assignments.uspto.gov/assignments>. Information on the status of pending assignment recordations may be obtained by calling (571) 272-3350 or 1 (800) 972-6382 (outside the Washington, DC Metro area).

October 2, 2007

AMANDA PUTNAM
Manager, Public Records Division